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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,339	04/18/2006	Jung Soo Ha	075820-0013	9401

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MCDERMOTT WILL & EMERY LLP  
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WASHINGTON, DC 20005-3096

EXAMINER
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KANG, IRENE S

ART UNIT	PAPER NUMBER
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3695

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12/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,339	<b>Applicant(s)</b> HA ET AL.	
	<b>Examiner</b> IRENE KANG	<b>Art Unit</b> 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/03/2009</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 1-12 are currently pending in the instant application. Applicant elected claims 1-6, 10, and 11 without traverse on August 11, 2009, after a restriction requirement. Claims 7-9, and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim.

### ***Response to Amendments and Arguments***

As to the rejection of claims 1-6, 10, and 11 under 35 U.S.C. § 103, Applicant's arguments are moot given new grounds of rejection for the claims as amended.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-6** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In reference to Claims 1-6:

**Claim 1** is directed toward the statutory category of a method (process), however according to Supreme Court precedent and recent Federal Circuit decisions, in order to be statutory under 35 USC 101 the process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials to a different state or thing. If neither of these requirements is met by the claim, the method is not a

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patent eligible process under § 101 and is rejected as being directed toward non-statutory subject matter.

As example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter being transformed, for example by identifying the material being changed to a different state. (*Diamond v. Diehr*, 450 US 175, 184 (1981); *Parker V. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 US 63, 70 (1972); *Cochrane v Deener*, 94 US 780, 787-88 (1876)). Applicant is also directed to MPEP § 2173.05p, providing guidance with respect to reciting a product and process in the same claim and MPEP § 2111.02 [R3] providing guidance with respect to the effect of limitations within the preamble of a claim.

**Claims 2-6** depend upon claim 1 contain the same deficiencies and do not cure the deficiencies set forth above. Therefore Claims 2-6 are also rejected for being directed to non-statutory subject matter.

In reference to Claim 10:

As per **Claim 10**, Applicant's specification defines "computer readable medium" to include "transmission medium such as optical or metallic lines, wave guides, etc. including a carrier wave transmitting signals specifying the program instructions, data structures, etc." [see Applicant's Specification, page 17]. Per the MPEP 2106.01, computer programs are only statutory when recorded on a computer readable medium such that the program instructions are "structurally and functionally interrelated to the medium". A computer-readable medium

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encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and would be statutory. Since Applicant's claim and specification reads on both statutory and non-statutory subject matter such rejection is proper.

In reference to Claim 11:

As to **Claim 11**, independent Claim 11 recites a system with units for purchase request processing, payment means providing, payment performing, and sales requesting. This is considered to be software per se unless there is an apparatus as well that is capable of executing the software appropriately in order to provide functionality. In other words, for applicant to claim the steps performed by the program, the applicant must recite the claims such that when the program is executed, the program causes a computer/processor to perform the steps.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1, 2, 4, 5, 10, and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over the publication by Frank S. Yuan (Publication No.: US 2002/0038277) in view of the patent by Carlisle et al. (Patent No.: 5,649,118), further in view of the International Publication by Yun et al. (International Publication No.: WO 01/63520 A1) submitted in Applicant's IDS on August 3, 2009.

**As to Claim 1**, *Yuan* teaches a method for providing a partial payment in the electronic commerce via the Internet (see at least Abstract, ¶[0002], ¶[0003], and ¶[0005]), the method comprising the steps of:

receiving request information for purchase of goods from a user (see at least ¶[0004], ¶[0099], and ¶[0176] through ¶[0178]);

transmitting result information of the performed payment to the user (see at least Abstract, Figure 7, ¶[0072], ¶[0084], and ¶[0087]); and

transmitting request information for sale of said goods based on said result information of the performed payment (see at least Abstract, Figure 8, ¶[0072], ¶[0084], and ¶[0087]).

Although *Yuan* substantially teaches the disclosed invention, it does not specifically disclose in response thereto, transmitting information on purchase particulars related to said goods including price of the goods to the user; transmitting payment means information including a plurality of payment means to the user; receiving selection information on at least

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two payment means from the user, wherein the at least two payment means are selected by the user; and performing a partial payment, by which at least two portions of the price of the goods are paid by the at least two payment means. *Carlisle* does teach in response thereto, transmitting information on purchase particulars related to said goods including price of the goods to the user (see at least Col. 3, lines 38-54); transmitting payment means information including a plurality of payment means to the user (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67); receiving selection information on at least two payment means from the user (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67); and performing a partial payment, by which at least two portions of the price of the goods are paid by the at least two payment means (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67). *Yun* teaches that the at least two payment means are selected by the user (see at least Page 11, 1<sup>st</sup> full ¶, and Page 12, 1<sup>st</sup> full ¶). It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the features of *Carlisle* and *Yun* into the invention of *Yuan* since all the inventions look to increase convenience for users of related payment systems and methods in electronic commerce.

**As to Claim 2,** *Carlisle* teaches that said plurality of payment means comprise at least one selected from a group consisting of cash, a credit card and a mobile phone (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67).

**As to Claim 4,** *Carlisle* teaches that said plurality of payment means comprise at least two different credit cards (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67).

**As to Claim 5**, *Carlisle* teaches that the partial payment is performed when the at least two portions of the price of the goods exceeds a predetermined value (see at least Figure 13; Figure 14; and Col. 21, line 37 through Col. 22, line 67).

**Claim 10** is a computer readable record medium recording a program for implementing the method according to Claim 1 and thereby rejected on the same grounds as Claim 1.

**Claim 11** is a system for performing the method according to Claim 1 and thereby rejected on the same grounds as Claim 1.

**Claims 3 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over the publication by Frank S. Yuan (Publication No.: US 2002/0038277) in view of the patent by Carlisle et al. (Patent No.: 5,649,118) in view of Cole et al. (Publication No.: US 2002/0161707), further in view of the International Publication by Yun et al. (International Publication No.: WO 01/63520 A1) submitted in Applicant's IDS on August 3, 2009.

**As to Claim 3**, *Cole* teaches the method further comprising the steps of, in case that a cash payment is included in the selection information, transmitting account information to the user and receiving information on receipt of money related to the account wherein said request information for sale is transmitted after receiving the information on receipt of money (see at least Abstract, Figure 26, Figure 27, Figure 33, ¶[0015], ¶[0016], ¶[0068], ¶[0130]).

Although *Yuan*, *Carlisle*, and *Yun* substantially teach the disclosed invention, they do not specifically disclose the method further comprising the steps of, in case that a cash payment is included in the selection information, transmitting account information to the user and receiving information on receipt of money related to the account wherein said request information for sale



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is transmitted after receiving the information on receipt of money. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the features of *Cole* into the inventions of *Yuan*, *Carlisle*, and *Yun* since all the inventions look to increase convenience for users of related payment systems and methods in electronic commerce.

**As to Claim 6**, *Cole* teaches that said plurality of payment means comprise a plurality of credit cards and the number of the credit cards is restricted below a predetermined number (see at least Abstract, Figure 11, ¶[0013], and ¶[0099]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IRENE KANG whose telephone number is (571)270-3611. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571)272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3695  
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